

Appl. No. 10/023,365
Amdt. dated May 19, 2004
Reply to Office action of November 21, 2003
Attorney Docket No. 11557.02
Express Mail No. EV 423 773 392 US

REMARKS

Claims 1-32 are under examination in the case. Applicants have withdrawn claims 27-32 from consideration. Applicants respectfully request reconsideration of the outstanding rejections for the reasons that follow.

Response to Oath/Declaration

The Examiner noted that the oath or declaration as previously filed is defective for failure to list US Patent Application No. 09/939,141. Applicant submits a new oath or declaration herewith, the new oath or declaration is believed to be in compliance with 37 CFR 1.67(a).

Response to Claim Objection

Claim 5 is objected to because of minor informalities within the claim language. Applicant agrees with the Examiner and has corrected the problematic language where appropriate. As such, Applicant respectfully requests that the claim objection be withdrawn.

Response to Claim Rejections – 35 USC §112

Claims 1-26 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner contends that claims 1-26 include problematic language that makes each of these claims indefinite. Applicant has amended claims 1, 2 and 19 above in accordance with the Examiner's suggestions. Accordingly, Applicant request that the §112, second paragraph rejection be withdrawn.

Response to Claim Rejections – 35 USC §102

Claims 1 - 20 are rejected under 35 U.S.C. §102(b) as being anticipated by Rault-Berthelot et al (New Journal of Chemistry (1986), V10, No. 3, 169-177). Applicant respectfully traverses.

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Applicant claim 1 is directed toward a method for the production of a polymer using two electrolysis steps, a first electrolysis of an aromatic compound having at least one cyclopentane structure. The first electrolysis performed in the presence of an ester and an electrolyte. And a second electrolysis (electrolytic oxidation) on the polymer formed in the first electrolysis. The second electrolysis performed in the presence of an ester and an electrolyte. The product of the two step reaction is a cyclopentanone. Rault-Berthelot does not teach or suggest all of the claim limitations as found in claim 1.

Rault-Berthelot teaches the production of cyclopentene using an anodic sweep and cathodic sweep in a cyclic voltammetry procedure. The disclosed method, as shown in Figure 1 (page 171), has only a single repeatable step that results in the formation of a cyclopentene. Rault-Berthelot never teaches or suggests the method of producing a cyclopentanone via a two step electrolysis as recited in claim 1. Therefore, Applicant respectfully request withdrawal of the rejection to claim 1.

Applicant notes that the Examiner recites several other rejections to dependent claims as based on Rault-Berthelot. These rejections are not addressed herein, as Applicant believes claims 2-20 are allowable for the same reasons that claim 1 is believed allowable.

Claims Indicated Allowable

The Examiner indicated that claims 21-26 would be allowable if rewritten in independent form including all of the limitations of any base claims and intervening claims, and/or amended to overcome the Examiner's claim rejections under 35 U.S.C. § 112. Applicant notes that these claims have been amended to overcome the Examiner's claim rejections with respect to 35 U.S.C. §112. In light of the amendments above and preceding remarks, Applicant respectfully requests allowance of claims 21-26.

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Conclusion

Claims 1-26 of this application are pending and claims 27-32 are withdrawn. In light of the foregoing amendments and remarks, it is believed that the application is in condition for allowance, and prompt allowance is respectfully solicited.

This amendment is believed to be responsive to all points in the Office action and is believed to put the case in condition for allowance. Should the Examiner have any remaining questions, she is encouraged to contact the undersigned attorney at the telephone number below to expeditiously resolve such concerns.

This Amendment is filed contemporaneously with a Petition for a Three-Month Extension of Time and associated \$475.00 fee. Should any additional filing fees associated with this amendment be necessary, please consider this a request therefor and charge Deposit Account No. 04-1415 as necessary.

The Applicant thanks the Examiner for her thorough review of the claims in this application.

Dated this 19 day of May, 2004

Respectfully submitted:



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cc: IP Docketing